REMARKS

The above amendments and these remarks are responsive to the Office action mailed July 13, 2006. Claims 1-38 are pending in the application. Claims 1-6, 8-9, 13-29, 31-34, and 37-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura et al. (U.S. Patent No. 5,989,658) and Lee et al. (U.S. Patent No. 6,830,497). Claims 7 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura et al. and Lee et al. in view of Dahl (U.S. Patent No. 3,284,947). Claims 10-12, 30 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura et al. and Lee et al. in view of Piotrovsky (U.S. Patent No. 4,470,784).

In view of the amendments above, and the remarks below, applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

Rejections under 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings, there must be a reasonable expectation of success, and the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2142.

Claims 1-6, 8-9, 13-29, 31-34, and 37-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura et al. and Lee et al. Applicant traverses the rejection and respectfully submits that there is no suggestion or motivation within the prior art to combine the teachings of Miura et al. and Lee et al.

Miura et al. appears to disclose a joint assembly which is capable of a click motion to maintain a user-defined position and a process for manufacturing such a joint (column 1, line 63 - column 2, line 13), as shown below in Figs. 26 and 29. Several materials are used which differ by melting point so as not to weld the joint components in a fixed position during the four-step molding process.

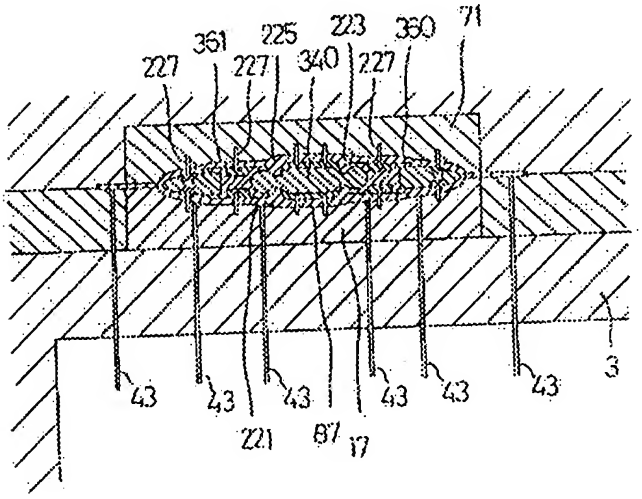


FIG. 26

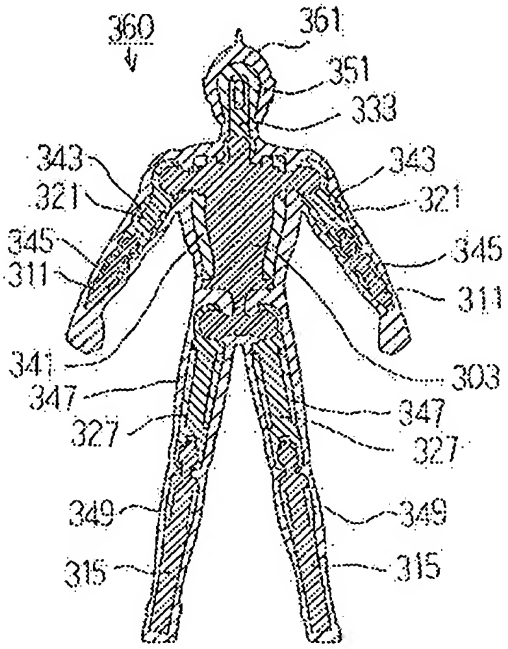


FIG. 29

Lee et al. appears to disclose a toy figure having articulating limbs that are vertically injection molded. Pivot joints connect the limbs to one another and the torso of the figure. A first material forms an elongate member and a second material forms adjacent limb segments that enclose the elongate member (column 1, line 49 – column 2, line 26). The thigh of the figure is formed by complementary leg segment shells 142a, 142b that encase joint components of the mid-thigh and knee (column 8, lines 20-42; Figs. 1-2), as shown in Fig. 2.

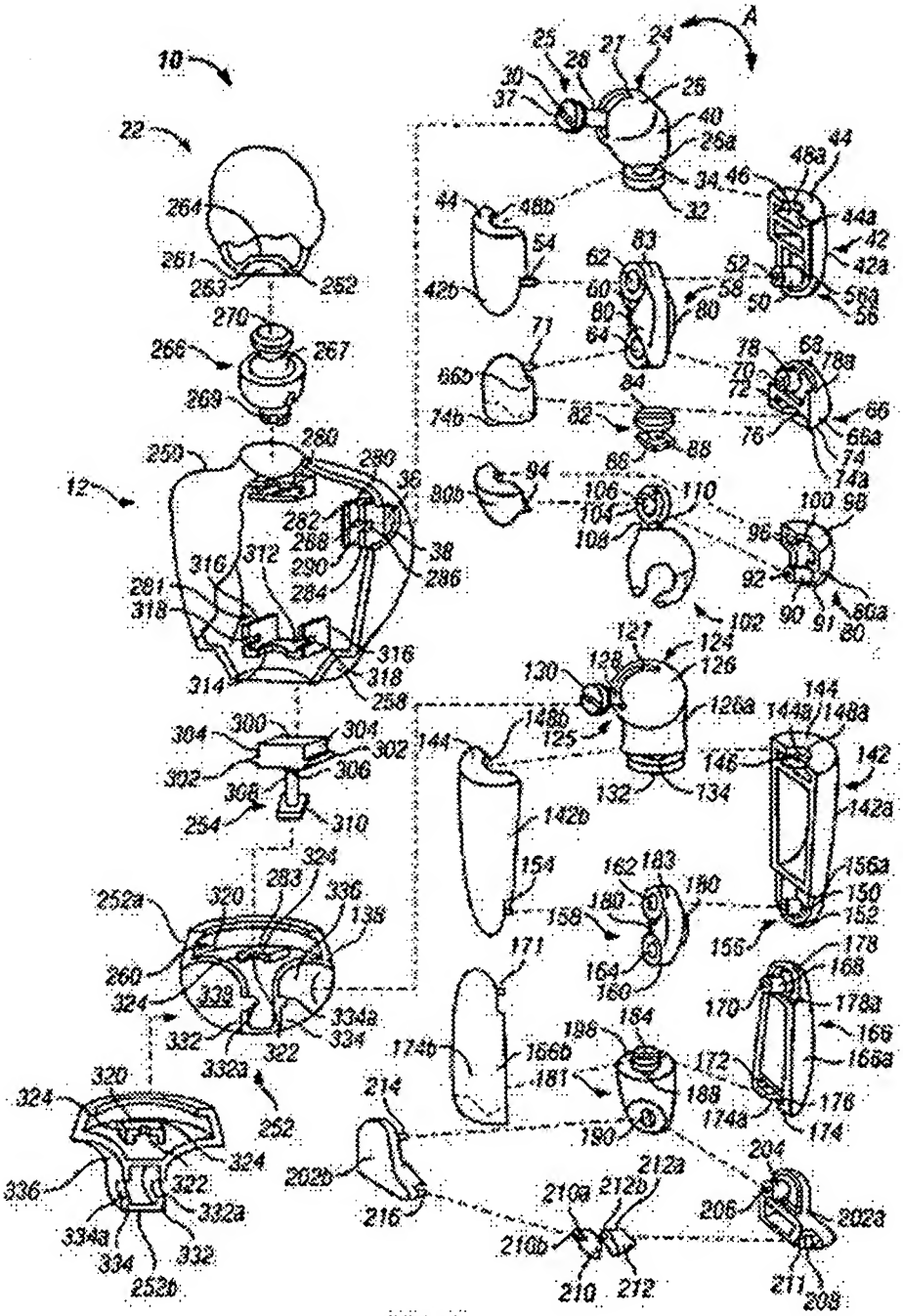


FIG. 2

It would be inappropriate to form such a combination since applying the outer covering of Miura et al. to the limb components of Lee et al. would substantially restrict motion of the limb components of Lee et al., thereby rendering Lee et al. substantially inoperative. Additionally, it is doubtful that a uniform outer covering could be applied to the figure of Lee et al. while maintaining the full range of motion since the joints of Lee et al., such as those in the

hand, are very small. It would also be difficult to control which of the several joints were being rotated if the joint structures of Lee et al. were covered. For example, each arm and leg segment of Lee et al. includes a joint that allows rotation along that limb segment (column 5, lines 35-38; column 8, lines 20-23). Such rotation would be substantially restricted if an outer covering were applied to the figure. In particular, Lee et al. teaches away from placing another layer on leg segment 142, thereby turning this segment into an insert, since the second leg segment 142 is capable of rotating 360° with respect to the first leg segment 124 (column 8, lines 34-38). Using leg segment 142 as an insert would eliminate its functionality.

Moreover, such a combination fails to disclose, teach, or suggest a hollow body portion configured to form an inner supporting structure for an appendage of a toy figure, the body portion configured to occupy at least 50% of a volume of the appendage, as recited in claim 1. The toy figure of Miura et al. consists of several solid layers of injection molded material and therefore fails to disclose, teach, or suggest a hollow insert. This deficiency is not accounted for by Lee et al. Instead, Lee et al. discloses an outer cover in the form of two shells 142a, 142b to enclose joint components, such as disk 132 (column 8, lines 20-42). Consequently, claim 1 is patentably distinguishable over the combination of Miura et al. and Lee et al.

For the above reasons, applicant respectfully requests the rejection of claim 1 be withdrawn. Claims 2-6, 8-9, and 13-15 depend from and further limit claim 1. Claims 2-6, 8-9, and 13-15 should therefore be allowed when claim 1 is allowed.

For the above reasons stated with respect to claim 1, applicant respectfully requests the rejection of claim 16 also be withdrawn. Additionally, in the interests of furthering the prosecution of the application, claim 16 has been amended to recite a first body segment and a second body segment detachably joined with the first body segment to form a substantially

hollow body of the insert, the hollow body including a plurality of stabilization pegs for stabilizing the insert within a mold. In contrast, Miura et al. discloses in Figs. 26 a mold including engaging protrusions 227. In particular, mold portions 17, 71 have recesses 221, 222 that form a mold cavity 225 for molding a covering member 361. Engaging protrusions 227 are provided as integral or separate parts in the mold recesses (column 12, lines 47-63; column 17, lines 39-41; column 17, line 64 – column 18, line 2). Consequently, claim 16 is patentably distinguishable over the combination of Miura et al. and Lee et al. Claims 17-24 depend from and further limit claim 16 and should therefore be allowed when claim 16 is allowed.

For the above reasons stated with respect to claim 1, applicant respectfully requests the rejection of claims 25 and 31 also be withdrawn. Claims 26-30 depend from and further limit claim 25 and should therefore be allowed when claim 25 is allowed. Claims 32-38 depend from and further limit claim 31 and should therefore be allowed when claim 31 is allowed.

Claims 7 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura et al. and Lee et al. in view of Dahl. Applicant traverses the rejection and respectfully submits that there is no suggestion or motivation within the prior art to combine the teachings of Miura et al., Lee et al., and Dahl. Claim 7 depends from and further limits claim 1 and should therefore be allowed when claim 1 is allowed. Claim 35 depends from and further limits claim 31 and should therefore be allowed when claim 31 is allowed. The rejection of claims 7 and 35 should therefore be withdrawn.

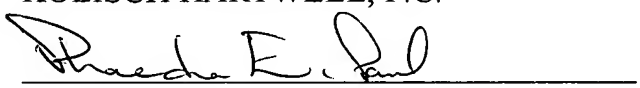
Claims 10-12, 30 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura et al. and Lee et al. in view of Piotrovsky. Applicant traverses the rejection and respectfully submits that there is no suggestion or motivation within the prior art to combine the teachings of Miura et al., Lee et al., and Piotrovsky. Claims 10-12 depend from and further limit

claim 1 and should therefore be allowed when claim 1 is allowed. Claim 30 depends from and further limits claim 25 and should therefore be allowed when claim 25 is allowed. Claim 36 depends from and further limits claim 31 and should therefore be allowed when claim 31 is allowed.

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

KOLISCH HARTWELL, P.C.



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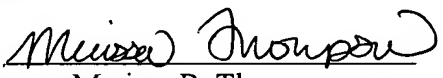

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